

REMARKS

This Amendment is submitted in response to an Office Action (non-final) dated April 6, 2005, the shortened statutory period for response having expired on July 6, 2005. Accordingly, a petition for an extension of time and associated fee are enclosed. In the event that the Commissioner determines that an additional extension of time is required, the undersigned hereby petitions for such extension and authorizes the Commissioner to charge the Milbank deposit account 13-3250 for any required fee.

I. Status of the Claims

By the Amendment above, claims 1-20 and 24-29 are cancelled without prejudice to prosecution in a later-filed application, and claims 21-23 are amended. Claims 21-23 are now pending, with claim 23 an independent claim.

II. Rejections under 35 U.S.C. § 101

In the April 6, 2005 Office Action, the Examiner has maintained the rejection of claims 1-23, 28 and 29 under 35 U.S.C. § 101 as directed to non-statutory matter, on the basis that the claims are not within the technological arts. As support for the rejection, the Examiner relies on *Ex parte Bowman*, 61 USPQ2d 1665, and MPEP §2106 IV B.2 (b) ii). The Examiner recommends a positive recitation of a computer in the claims to overcome the rejection. Applicants thank the Examiner for withdrawing the earlier rejection under § 101 as not producing a useful, concrete or tangible result.

Applicants respectfully submit that the claims as drafted are directed to statutory subject matter, and that *Bowman* and the cited section of the MPEP does not support the rejection. Applicants further submit that use of a non-precedential and unpublished opinion as

the basis for rejection under § 101 is improper and unsupported and ask that the rejection be withdrawn.

Finally, the facts of *Bowman* are clearly distinguishable from this application. The Examiner in *Bowman* asserted that “the claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed.”¹ On appeal, the Board of Patent Appeals and Interferences agreed with the Examiner and stated that the Appellant had “carefully avoided tying the disclosed and claimed invention to any technological art or environment.”² The Board also noted that the U.S. Patent and Trademark Office Examination Guidelines for Computer Related Inventions “[were] not dispositive ... because there [was] absolutely no indication ... that the invention [was] connected to a computer in any manner.”³

In a concurring opinion, Administrative Patent Judge Dixon elaborated on reasons why *Bowman* was distinguishable from other precedent. In particular, Judge Dixon noted that “the [Bowman] specification is silent as to the need for any apparatus to carry out the claimed process.”⁴ Judge Dixon then contrasted *Bowman* with *State Street Bank, Alappat*⁵ and *Arrhythmia*⁶, where the disclosed inventions were in a technological art.⁷ Judge Dixon also admitted that under *AT&T*⁸, “structure need not be present in the claim language for process claims to be directed to statutory subject matter.”⁹

Accordingly, *Bowman* is clearly limited to the circumstance where there is no

¹ *Bowman* 61 U.S.P.Q.2d at 1671 (emphasis added).

² *Id.*

³ *Id.*

⁴ *Id.*, at 1673 (emphasis added).

⁵ *In re Alappat*, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994).

⁶ *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 22 U.S.P.Q.2d 1033 (Fed. Cir. 1992).

⁷ *Bowman*, 61 U.S.P.Q.2d at 1674.

⁸ *AT & T Corp. v. Excel Communications Inc.*, 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999).

disclosure of structure.

The instant application clearly discloses structure. For example, figure 1 illustrates a computer and associated structure including a processor, removable storage media, user interface, output device, memory, and input device. That structure is described in the specification at pages 7-9. Thus, in sharp contrast to the total lack of disclosed structure in *Bowman*, the instant application includes a disclosure of structure, and is therefore distinguishable from *Bowman*. Accordingly, Applicants submit that the rejection under § 101 is without factual or legal support.

However, in the interest of advancing the claims to allowance, Applicants have amended the pending claims to recite the method at least partially implemented in a computer, and submit that the basis for rejection under § 101 is therefore overcome. This amendment is without prejudice to later-filed claims without such language.

III. Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-23, 28 and 29 as being unpatentable under 35 U.S.C. § 103 over Irving et al (U.S. Patent No. 5,991,743) in view of Kealhofer (U.S. Patent No. 6,078,903) and Shumway.

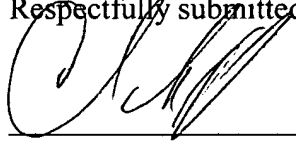
During a telephone interview with the Examiner on May 20, 2005, the undersigned proposed an amendment to claim 23 that would change the language from “substantially in the form” to “mathematically equivalent to”, and the Examiner later indicated that such an amendment would likely overcome the rejection under § 103. Accordingly, Applicants have amended claim 23 as proposed in the interview, and have amended claims 21 and 22 to depend from claim 23.

⁹ *Bowman*, 61 U.S.P.Q.2d at 1674.

IV. Request for Reconsideration

It is respectfully submitted that the present application is in condition for allowance and prompt notification thereof is requested. If the prosecution of this application can be advanced by a telephone conference, the Examiner is requested to call the undersigned at (212) 530-5000.

Respectfully submitted,



Dated: July 20, 2005

Chris L. Holm
Registration No. 39,227
Milbank, Tweed, Hadley & McCloy LLP
1 Chase Manhattan Plaza
New York, NY 10005-1413
Telephone: (212) 530-5000
Facsimile: (212) 530-5219